

IV. Remarks.

The following rejections were entered by the Examiner.

1. Claims 1, 2, 4, and 6-11 are rejected under 35 USC 102(b) as being anticipated by Rückert (US 5,288,191).

The analysis with respect to anticipation requires that a strict standard be satisfied. The standard extends beyond simply identifying elements in the reference that are then compared to the claim, it requires that every element be present arranged as in the claim.

Rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.Cir.), cert. denied, 493 U.S. 853, 110 S.Ct. 154, 107 L.Ed.2d 112 (1989). An invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. Perkin-Elmer Corp., 732 F.2d at 894, 221 USPQ at 673; Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed.Cir.1983), cert. denied, 465 U.S. 1026, 104 S.Ct. 1284, 79 L.Ed.2d 687 (1984). The identical invention must be shown in as complete detail as is contained in the patent claim. Jamesbury Corp., 756 F.2d at 1560, 225 USPQ at 256; Connell, 722 F.2d at 1548, 220 USPQ at 198.

As to amended claim 1 and 7, Rückert does not teach a stop having a substantially annular form that extends partially about an outer circumference of the first body such that the stop partially overlaps the structural part as claimed. The Examiner argues that hooks (15) have a substantially annular form and therefore anticipate the limitation "a member comprising a stop having a substantially annular form that extends partially about an outer circumference of the first body such that the stop partially overlaps the structural part". This is an overbroad interpretation of the reference which is not supported by its teachings.

Hooks (15) simply protrude from the bottom side of socket 10, col. 4, lines 21-22. No teaching is offered in the reference that the hooks having a substantially annular form. Nor is this finding inherent since the shape of a protrusion is not necessarily dependent upon the shape of the member from which it protrudes, which assertion appears to be the sole basis of the Examiner's argument. This assertion is defeated by the presence of the resilient sections 16 which extend from the ends of hooks 15. Resilient sections 16 are bent portions of hooks 15. Since sections 16 are bent (Fig. 2) this points away from the Examiner's conclusion that hooks 15 are substantially annular. Every day experience teaches that a simple bend of the type in the reference causes the portions adjacent to the bend to be flat. This is strongly supported by Fig. 3 which is an end plan view of

hooks 15. Fig. 3 clearly shows that hooks 15 are flat. There is no annular portion taught for hooks 15, hence the limitation is not presented in the reference arranged as claimed. Therefore, rejection is not satisfied.

Claims 2, 4 and 6 depend directly or ultimately from claim 1.

Claims 8-11 depend directly or ultimately from claim 7.

2. Claims 3 and 5 are rejected under 35 USC 103(a) as being unpatentable over Rückert as applied to claims 1 and 2 above, and further in view of Ozawa (US 6,779,957).

A rejection based on 35 U.S.C. § 103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. Thus, in the context of an analysis under § 103, it is not sufficient merely to identify one reference that teaches several of the limitations of a claim and another that teaches several limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. Interconnect Planning Corp. v. Fiel, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985); In Re Corkhill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. (BNA) 1005, 1009-10 (Fed. Cir. 1985). The relevant analysis invokes a cornerstone principle of patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is . . . simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698 (Fed. Cir. 1983) (other citations omitted).

A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose without producing anything beyond the results inherent in their use. American Hoist & Derek Co. v. Sowa & Sons, Inc., 220 U.S.P.Q. (BNA) 763, 771 (Fed. Cir. 1984) (emphasis in original, other citations omitted).

As the Court of Appeals for the Federal Circuit recently noted, “[w]hen a rejection depends upon a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” Ecolchem, Inc. v. Southern Calif. Edison, 56 U.S.P.Q. 2d 1065, 1073 (Fed. Cir. 2000). There must be a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). This is because “combining prior art references without evidence of such a suggestion, teaching, or

motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability." *Id.* Accordingly, to establish a rejection under 35 U.S.C. § 103, a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation to combine the prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Ozawa teaches a bolt for integrally fastening a first member and a second member, which are spaced away to each other, the bolt comprising a cylindrical-shaped collar bolt provided on a portion of an outer peripheral surface thereof with an external thread portion and on an inner peripheral surface thereof with an internal thread portion; and a bolt body having in an area of one end of a shank an external thread portion capable of threading into the internal thread portion of the collar bolt and a head on the other end thereof.

As to claim 3, there is no incentive to combine the references. The significant torque required to overcome the frictional lock between the proposed sacrificial threads and the distance plate 1 nullifies any incentive to make the proposed combination. Rückert teaches use of a clamping ring 5 which enters into a friction lock with a screw 4, col. 4 lines 1-4. The friction lock is used to turn a distance plate 1 which then translates along the screw 4, col. 4, lines 48-61. The threads taught in Ozawa (8,11) if used in lieu of clamping ring 5 would prevent distance plate 1 from translating along the length of screw 4. This is because once screw 4 has fully engaged a sacrificial thread on distance plate 1 the torque required to then force distance plate 1 to translate along screw 4 would be significant because the engagement with the deformed sacrificial thread would present a significant frictional force operating against such translation of the distance plate 1. In effect distance plate 1 would have to "climb" screw 4. The teaching in Rückert indicates that clamping ring 5 is intended to create only the minimal friction necessary to allow distance plate 1 to rotate in annular part 7, col. 4, lines 57-61. Use of a sacrificial thread defeats that purpose.

The Examiner has offered no reason as to why this would be a desirable combination. The Examiner does state that "the sacrificial threads would provide for a more secure connection between the fastener and the second body/bushing preventing inadvertent separation of the fastener." However, as argued above is it just this prevention of separation that renders the proposed combination inoperable and undesirable.

As to claims 3 and 5, each depend directly or ultimately from amended claim 1.

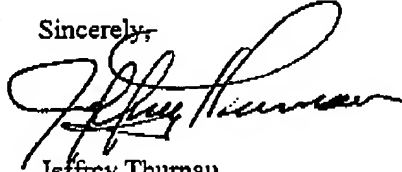
Applicant requests that all claims be passed to allowance.

V. Fees.

Any fees payable for this petition for extension of time and amendment, or which may be otherwise required to avoid abandonment of the application, may be deducted from deposit account 07-0475 in the name of The Gates Corporation.

Thank you for your attention to this case. If any questions arise, please call at the number below.

Sincerely,



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